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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,830	01/11/2000	KURT H LOHSE	LOHSE-1	7571

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EXAMINER

LAstra, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/482,830

Applicant(s)

LOHSE, KURT H

Examiner

DANIEL LASTRA

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7, 15, 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 3-7, 15 and 16 have been examined. Application 09/482,830 (Method for providing discount incentives to potential customers who wish to make an immediate purchase) has a filing date 01/11/2000.

Claim Rejections - 35 USC § 112

2. Claims 3-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant amended claims 3-7 to be dependent of cancel claim 1. For purpose of art rejection, claims 3-6 are made dependent of claim 15 and claim 7 is dependent of claim 6.

Response to Amendment

3. Applicant amendment added new claim 16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims ⁴~~3~~ 7, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie et al (U.S. 6,014,634) in view of Deaton et al (U.S. 6,516,302).

As per claim 15, Scroggie et al teach:

A method for providing discount incentives to potential customers including the steps of:

a. establishing a website for a set of providers to set their respective discount parameters (column 4, lines 1-6; 25-30);

b. providing access to said website by a potential customer for selecting a provider from said set of providers (see column 3, lines 10-50).

c. transmitting a customer spending amount to said website by said potential customer (see column 7, lines 65-67);

Scroggie fails to teach:

d. querying said provider's discount parameters to establish whether said provider has a discount parameter matching said potential customer's spending amount; and

e. determining whether a provider's discount parameters match said customer spending amount and (1) returning to step (b) if no match is found, and (2) presenting a website display of a customer discount coupon corresponding to said discount parameters for printout by said potential customer for subsequent redemption if a match is found.

However, Deaton teaches about a system where customers transmit the value amount that they are expecting to spend at an online store and the system provides a discount based on that "value." For example, the discount rate may be greater for customers who spend more than those who spend less. Deaton teaches that, "In a particular example, a threshold is set at \$50 and customers who spend less than \$50 get no discount and customers who spend more than \$50 get 5% off the total purchase. This is an example of non-linear differentiation. In another example, customers who spend less than \$50 get a 2% discount and those spend more than \$50 get a 5% discount" (see column 136, line 45 - column 137, line 7; column 149, line 60 - column 150; columns 123-124). In addition, Deaton teaches about different coupons that are printed depending on the amount spent by the customer in a particular store (see column 84). Further, Scroggie teaches about a dynamic coupon creation system where coupons are created in real time using information provided by the consumer at his or her remote location. The total amount of savings and the terms for receiving savings are created in real time depending upon the information that the customer inputs (see column 10, line 26 - column 11, line 8). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that

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Scroggie would add the non-linear differentiation taught by Deaton where the proportionality of the reward or incentive changes as a percentage of the total purchase. In the Scroggie system, customers would input the total amount that they are expecting to spend by transmitting to the provider's website a shopping list and the system would create in real time the coupon with the corresponding discount that correlates with the specific customer's expected total purchase amount, as taught by Deaton. The Scroggie dynamic coupon creation system would generate a different coupon depending upon the customer's geographic location and expected spending amount, serving as a better targeting tool and incentive for customers to visit the store and purchase products.

As per claim 4, Scroggie et al teach:

The method recited in claim 15 further comprising the step of establishing a data file of coupon generation for each said provider (see column 4, lines 1-6).

As per claim 5, Scroggie et al teach:

The method recited in claim 15 further comprising the step of including at least one verification number on each said discount coupon (see figure 11).

As per claim 6, Scroggie et al teach:

The method recited in claim 15 further comprising the step of displaying a search page at said website for permitting a potential customer to search for a provider based upon selected criteria (see columns 3-4).

As per claim 7, Scroggie et al teach:

The method recited in claim 6 wherein said search criteria comprise at least one criterion taken from the group consisting of location, nature of products offered, nature of services offered and timing of provider registration at said website (see columns 3-4).

As per claim 16, Scroggie teaches:

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A method for providing discount incentives to potential customers, the method comprising the steps of:

a. establishing a website for a set of providers to set their respective discount parameters (column 4, lines 1-6; 25-30);

b. providing access to said website by a potential customer for selecting a provider from said set of providers (see column 3, lines 10-50).

Scroggie fails to teach:

c. transmitting to said website by said potential customer a minimum amount proposed to be spent at a future visit to said selected provider. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Scroggie's shopping list would indicate the minimum amount proposed by the user to be spent at a future visit to a provider (see column 7, lines 65-67). Because the customers can add items to the shopping list later, at least the first shopping list created and transmitted to the provider's web site would indicate the minimum amount the customer is expecting to spend.

d. querying said selected provider's discount parameters to establish whether said provider has a discount parameter corresponding to said potential customer's proposed spending amount; and

e. determining whether a provider's discount parameters to correspond to said customer spending amount and (1) returning to step (b) if no correspondence is found, and (2) presenting a website display of a customer discount coupon corresponding to

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said discount parameters for printout by said potential customer for subsequent redemption if a correspondence is found.

However, Deaton teaches about a system where customers transmit the value amount that they are expecting to spend at an online store and the system provides a discount based on that "value." For example, the discount rate may be greater for customers who spend more than those who spend less. Deaton teaches that, "In a particular example, a threshold is set at \$50 and customers who spend less than \$50 get no discount and customers who spend more than \$50 get 5% off the total purchase. This is an example of non-linear differentiation. In another example, customers who spend less than \$50 get a 2% discount and those spend more than \$50 get a 5% discount" (see column 136, line 45 - column 137, line 7; column 149, line 60 - column 150; columns 123-124). In addition, Deaton teaches about different coupons that are printed depending on the amount spent by the customer in a particular store (see column 84). Further, Scroggie teaches about a dynamic coupon creation system where coupons are created in real time using information provided by the consumer at his or her remote location. The total amount of savings and the terms for receiving savings are created in real time depending upon the information that the customer inputs (see column 10, line 26 - column 11, line 8). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Scroggie would add the non-linear differentiation taught by Deaton where the proportionality of the reward or incentive changes as a percentage of the total purchase. In the Scroggie system, customers would input the total amount that they are expecting

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to spend by transmitting to the provider's website a shopping list and the system would create in real time the coupon with the corresponding discount that correlates with the specific customer's expected total purchase amount, as taught by Deaton. The Scroggie dynamic coupon creation system would generate a different coupon depending upon the customer's geographic location and expected spending amount, serving as a better targeting tool and incentive for customers to visit the store and purchase products.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie et al (U.S. 6,014,634) in view of Deaton et al (U.S. 6,516,302) and further in view of the article YahooAddsMaps of 50 Cities.

As per claim 3, Scroggie et al fail to teach:

The method recited in claim 15 wherein said step (e) further comprises the steps of generating a map indicating the location of said selected provider and adding said map to said website display. However, the article YahooAddsMaps of 50 Cities teaches that any website which contains location content can easily add mapping features and services (see paragraph 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Scroggie would include mapping capabilities to guide customers to the stores where they would redeem the coupons.

Response to Arguments

5. Applicant's arguments filed 01/12/04 have been fully considered but they are not persuasive. The Applicant argues that the Scroggie and Deaton patents are primarily grocery applications designed to benefit product manufacturers and with some

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flexibilities to accommodate the needs of grocery retailers. The Applicant argues that shopping lists are not part of the normal shopping routine because most shoppers do not generally know every item they will buy, no do they buy the exact same products and brands over and over again. The Applicant argues that Scroggie's patent is fundamentally rooted in past purchase data making the notion of using future purchase data completely foreign to him and thoroughly unobvious.

The Examiner answers that Scroggie's shopping list indicates items that customers intend to purchase in a future visit to a store and therefore indicates the amount a customer proposed to spend at a future visit to a provider. Applicant claim 15 recites "transmitting a customer spending amount to said website by said potential customer" and claim 16 recites "transmitting to said website by said potential customer a minimum amount proposed spending amount", and the shopping list as described in Scroggie, reads into claims 15 and 16. Also, the Applicant is arguing about items that are not in the claims when he argues that shopping lists are not part of the normal shopping routine because most shoppers do not generally know every item they will buy, no do they buy the exact same products and brands over and over again.

The Applicant further argues that Deaton's patent does not mention anything about the critical data entry field required to accurately capture total future spend value from the consumer directly. The Examiner answers that Scroggie's shopping list captures the total future spend value of the customer (see column 7, lines 65-67; column 10, lines 9-41). And also Scroggie gives users the ability to select which items to select which items to include or exclude in the shopping list, therefore giving the data

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entry field required to accurately capture total future spend value from the customer (see column 7, lines 65-67).

The Applicant argues that the process of automatically calculating the combined price of a group of products from a list is not an accurate total value assessment simply because most people do not know every single item they will be buying prior to going shopping. The Applicant argues that even a good shopping list can represent only a portion of someone's total spend value/potential and by contrast, many shoppers plan to shop with a maximum budget amount in mind that helps them better to decide the type, quality, and number of possible products they will buy during their shopping experience.

The Examiner answers that the Applicant is arguing features that are not in the claims.

The Applicant argues that the Deaton method is different than the Lohse method but more technically cumbersome; it is also far more time-consuming, and uses an inferior process of approximating total purchase value in store for speciality retailers simply because there is no practical inventory solution available today that has the ability to list the availability of all products and services available in real time on a local store by store basis. The Applicant argues that list building methods have been proven commercially unprofitable by marketing companies due to the cumbersome shopping experience in both the list building and coupon redemption processes and due to lack of real-time product availability and inventory controls.

The Examiner answers that the Applicant is arguing about features that are not in the claims.

The Applicant argues that if it were obvious to Deaton or Scroggie to radically improve or simplify the process of deriving value from a shopper simply by creating a data entry field that asks the user to enter a planned total spending value and nothing more, then why was this step never once mentioned in the method.

The Examiner answers that Applicant claim 15 recites "transmitting a customer spending amount to said website by said potential customer" and claim 16 recites "transmitting to said website by said potential customer a minimum amount proposed spending amount", and the shopping list as described in Scroggie reads into claims 15 and 16.

The Applicant argues that there is a fundamental difference between the use of future vs historical purchase data for marketing purposes. System based on historical data require predictive guesswork. A system that utilizes future purchase data eliminates the need for guesswork or predictive modeling of any kind.

The Examiner answers that Scroggie's shopping list indicates a proposed future spending of the customer (see column 7, lines 65-67).

The Applicant argues that Lohse method allows buyers to anonymously negotiate custom retail discounts with sellers based on the specific value of a non-product specific purchase.

The Examiner answers that the Applicant is arguing about features that are not in the claims.

The Applicant argues that his method is a value-based discount reward system that dynamically generates individualized savings opportunities (memorialized through

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custom, printable coupons) created and defined by the exact dollar value entered by online buyers to shop in-store or online.

The Examiner answers that the Applicant is arguing features that are not in the claims.

The Applicant argues that his method is different from storing pre-determined coupons and enabling search and selection features for ease of viewing and distribution. The Applicant argues that there is a clear-cut distinction between making and finding coupons. The Applicant argues that his method is the only one capable of producing printable discounts that are truly unique in the spending requirements associated with the promotional discount.

The Examiner answers that Scroggie teaches the creation of dynamic coupon that are created in real time with parameters that are changed dynamically (see column 10, lines 26-41).

The Applicant argues that systems that value of products identified by an online shopping list cannot accurately predict the total purchase potential of shoppers prior to walking into a store. The Applicant argues that total spend budgets reflect a much more accurate glimpse into the minds of shoppers so that retailers can accurately know and respond to how much people are planning to spend in total while shopping.

The Examiner answers that the Applicant is arguing features that are not in the claims.

Applicant argues that his method makes coupon where other coupon system on or off the Internet displays or distributes pre-made and pre-determined discount offers

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no matter who is searching for a discount or how valuable the specific transaction is to the potential seller. The Applicant argues that each buyer request in the Lohse system is treated as a unique request, and as such, can create and present custom-made volume discounts on behalf of the retailer selected in real-time for the exact purchase amount desired by the buyer and more importantly, can dynamically present an additional incentive that rewards the customer for spending significantly more than they were intending.

The Examiner answers that the Applicant is arguing features that are not in the claims.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra

April 1, 2004

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